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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/913,643

10/19/2001

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07/11/2007

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ALEXANDRIA, VA 22314

EXAMINER

FUBARA, BLESSING M

ART UNIT

PAPER NUMBER

1618

MAIL DATE

DELIVERY MODE

07/11/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/913,643	Applicant(s) JOKINEN ET AL.	
	Examiner Blessing M. Fubara	Art Unit 1618	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 June 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

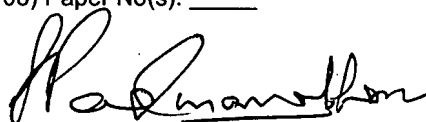
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 24-33.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because: The solubility rate of any fiber is an inherent characteristic of the fiber and the argument that the fiber of the claimed invention has unique solubility rate from that of Ahola is not persuasive and there is no factual showing providing solubility data of the claimed fiber and the Ahola fiber. Claim 30 is a product-by-process claim directed to biodegradable silica fibre that has a certain solubility rate in simulated body fluid and this certain solubility in the simulated fluid is a characteristic/property of the fiber such that any fiber in same environment, such as the simulated body fluid, would inherently have same solubility rate. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps and "[e]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process."

Contrary to applicant's argument that most of the fibers of Ahola's example 2 did not dissolve in vitro, it is noted that page 15, lines 12-15 discuss the dissolution of the fibers and lines 14 and 15 specifically states that "almost all fibers had integrated well into the surrounding connective tissue," it is further noted that on page 5, lines 15-18 disclose that the fibers "dissolve totally during the period desired when they are in contact with body fluid. ... and controllably," which further supports the fact that the fibers of Ahola dissolve controllably. Applicant has not factually shown the dissolution of the Ahola fiber to be 20 times slower because the conditions of example 2 of Ahola appears to be different from that of the claims for the following reasons: i) Example 1, page 15 at lines 14 and 15 specifically states that almost all the fibers are integrated into the tissue without specifying the time it took for the fibers to be integrated into the tissue and the amount of fibers integrated into the tissues; ii) Example 5 at page 17, lines 16-18, states that erosion of the fiber is fast during 28 days and then decrease, careful examination of Figure 1, shows that at 28 days, about 68% of the fiber has eroded, at 7 days, about 25% of the fiber has eroded; iii) Example 2 does not represent the erosion pattern of the fibers; iv) thus, a factual showing is necessary to show the differences in the dissolution of the claimed fiber and the fiber of the Ahola. Regarding applicant's argument against the DE reference, 196 09 551 that has a dissolution of 50 days vs. 21 days, it is noted that applicant has not provided factual evidence that the dissolution rates of the fibers of the DE reference differs from the claimed fibers when the analysis is conducted under the same conditions. The instant specification does not state that the fibers undergo complete dissolution within 21 days or within 5 days. The patent office does not have laboratory to factually show dissolutions of the claimed fiber and the fiber of the prior art. "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

The declaration under 37 CFR 1.132 filed 6/12/07 is insufficient to overcome the rejection of claims 24-33 based upon Ahola and DE 196 09 551 as set forth in the last Office action because: the declaration has not factually showed dissolution rates of the claimed fiber and the fibers of the prior art references where the rates of dissolution are measured or determined under the same conditions..

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